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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,473	07/29/2003	Takayoshi Togino	009523-0303920	4702

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PILLSBURY WINTHROP SHAW PITTMAN, LLP
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EXAMINER

TRAN, NHAN T

ART UNIT	PAPER NUMBER
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2622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/628,473	TOGINO, TAKAYOSHI	
	Examiner	Art Unit	
	Nhan T. Tran	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/29/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/016,805.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/016,805, filed on 1/30/1998.

Preliminary Amendment

2. Preliminary amendments, filed 7/29/2003, to specification and claims are acknowledged.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 7/29/2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

4. The title of the invention ("Portable Telephone") is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

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5. Claim 17 is objected to because of the following informalities: claim 17 recites "twp actions" in line 2 of the claim. This should be corrected to read as -- **two actions** -- . Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claims 10-18** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,633,337 in view of Ohnsorge (US 5,485,504).

Regarding claims 10-18, these claims of the instant application are *broader in every aspect* than the Patent claims 1-9, and are therefore respectively encompassed by the Patent claims 1-9 except for the limitation of "a portable telephone."

Although the Patent claims 1-9 direct to an electronic camera and do not claim a portable telephone, it is well recognized in the art that a portable handheld device can be constructed to incorporate both camera and telephone features in a single body so as to provide users maximum independence and freedom of movement like mobile telephones in addition to video capabilities as taught by Ohnsorge in Figs. 1 & 2 and col. 2, lines 20-29.

Therefore, it would have been obvious to one of ordinary skill in the art to construct a portable telephone in view of the teachings of the Patent claims 1-9 and Ohnsorge to arrive at the applicant's claimed invention so as to provide users maximum independence and freedom of movement like mobile telephones in addition to video capabilities as taught by Ohnsorge above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama et al. (US 5,689,736) in view of Ohnsorge (US 5,485,504).

Regarding claim 10, Okuyama discloses a portable apparatus (a video camera) comprising a phototaking optical system, two-dimensional image pickup element for receiving an object image formed by said phototaking optical system (see col. 2, line 40 in which a phototaking optical system and two-dimensional image pickup element are inherently included in the video camera), a two-dimensional display element (display 2 shown in Figs. 1A-2) for displaying said object image in the form of an image to be viewed (col. 4, lines 52-56), and a magnifying (enlarging) optical system (Fig. 1A & 2) for guiding said image to a viewer's eyeball (col. 2, lines 36-46 and col. 4, lines 26-56), wherein: said magnifying optical system includes a first reflecting surface (surface a) for turning back an optical path between said two-dimensional display element and said viewers eyeball to achieve compactness, said first reflecting surface being formed by a curved surface having an image-magnifying action (see Figs. 1A & 2 and col. 4, lines 47-51 and col. 2, lines 44-45).

Okuyama does not disclose that the portable apparatus is a portable telephone. However, it is well recognized in the art that a portable apparatus can be constructed to incorporate both camera and telephone features so as to provide users maximum independence and freedom of movement like mobile telephones in addition to video capabilities as taught by Ohnsorge in Figs. 1 & 2 and col. 2, lines 20-29.

Therefore, it would have been obvious to one of ordinary skill in the art to construct a portable telephone in view of the teachings of the Okuyama and Ohnsorge to arrive at the applicant's claimed invention so as to provide users maximum

independence and freedom of movement like mobile telephones in addition to video capabilities as taught by Ohnsorge above.

Regarding claim 11, it is also clear in Okuyama that said magnifying optical system further includes a second reflecting surface (surface b) located in opposition to said first reflecting surface (surface a) to turn back an optical path between said first reflecting surface and said second reflecting surface, thereby making a distance between said two-dimensional display element and said viewer's eyeball short (see Fig. 2).

Regarding claim 12, Okuyama further discloses that said first reflecting surface and said second reflecting surface are a prism member (Fig. 2 and col. 2, lines 64-67) made up of a transparent medium having a refractive index (n) greater than 1.3 ($N > 1.3$). See tables in col. 9 and col. 10, wherein the index of the prism is 1.49 ($n = 1.49$) which is greater than 1.3.

Regarding claim 13, Okuyama clearly shows in Figs. 1A & 2 that said first reflecting surface (surface a) is formed on one surface of said prism member, and said second reflecting surface (surface b) is located at a position where *a medium* of said prism member is *sandwiched* between said first reflecting surface and said second reflecting surface.

Regarding claim 14, also disclosed by Okuyama is that the second surface (surface b) is combined transmitting (transmitting light E to light sensor 6) and reflecting (reflecting light L) surface. See Fig. 2 and col. 5, lines 10-16.

Regarding claim 15, as shown in Fig. 2 and col. 3, lines 44-55 in Okuyama, at least one of said first reflecting surface or said second reflecting surface is formed by a rotationally asymmetric surface having an action to make correction for aberrations produced by decentration.

Regarding claim 16, Okuyama in view of Ohnsorge discloses that said two-dimensional image pickup element (image sensor 7 in Fig. 2 of Ota) is located in opposition (in vertical direction) to said two-dimensional display element (display 6 shown in Fig. 2 of Ota).

8. Claims 17/10 – 17/16 and 18/10 – 18/16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama et al. and in view of Ohnsorge and in further view of Nakao (US 5,161,025).

Regarding claims 17/10 – 17/16, although Okuyama discloses the magnifying optical system including one surface to guide an image displayed on the display element (2) to the view's eyeball as shown in Fig. 2, Okuyama and Ohnsorge do not explicitly disclose that said magnifying optical system has two actions, one to guide an

image displayed on said two-dimensional display element to said viewer's eyeball and the other to guide object light phototaken by said phototaking optical system directly to said viewer's eyeball.

Nakao teaches a video camera including a magnifying optical system (Figs. 1-6, 12 & 13) that has two actions realized by combined light transmitting and reflecting surface of an optical element (54 shown in Fig. 4 or 134 shown in Fig. 13) that transmits light when shutter 160 is open, and reflect light from two-dimensional display element (i.e., LCD 138, 140 shown in Fig. 13) when shutter 160 is in a hybrid mode so that the viewer can see either or both images from OVF and EVF in combination (see Nakao, col. 6, line 64 – col. 7, line 20)

Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings of Okuyama, Ohnsorge and Nakao to implement a magnifying optical system having two actions, one to guide an image displayed on said two-dimensional display element to said viewer's eyeball and the other to guide object light phototaken by said phototaking optical system directly to said viewer's eyeball for enabling a hybrid mode so that the view would be able to see either or both images from the optical viewfinder and the electronic viewfinder as necessary.

Regarding claim 18/10 - 18/16, Okuyama and Ohnsorge do not explicitly disclose specific circuitry located between the two-dimensional image pickup element and the two-dimensional display element as claimed. However, this lack of teaching is compensated by Nakao, Figs. 12 & 13, wherein, between the image sensor (122) and

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display element (138, 140), there are a signal processing circuit (124), a controller (126), a driver (164) and recording/reproducing unit (128) so that image received by the image pickup device and recorded in the recording/reproducing unit and is displayed at the same time on the two-dimensional display element (138,140) by the driver (164) being controlled by EVF controller (126) (see Nakao, col. 5, line 57 – col. 6, line 17; col. 7, line 24-44 and col. 10, lines 37-47).

Therefore, it would have been obvious to one of ordinary skill in the art to configure the portable telephone to include the teaching of Nakao for arranging a signal processing circuit, a controller, a driver and a recording/reproducing unit in between the image sensor and the display element to arrive at the applicant's claimed invention so as to capture and process image signals to display the image on the display unit for the user to review during photographing.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhan T. Tran whose telephone number is (571) 272-7371. The examiner can normally be reached on Monday - Friday, 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NHAN T. TRAN
Patent Examiner

A handwritten signature in black ink, appearing to read 'David Ometz', with a long horizontal stroke extending to the right.

DAVID OMETZ
SUPERVISORY PATENT EXAMINER